

**REMARKS**

The application has been carefully reviewed in light of the Final Office Action mailed December 19, 2005. In the Final Office Action, claims 1-24 are pending and Examiner rejects claims 1-24. Applicants amend claims 1, 11, and 18. Applicants submit that the claim amendments do not add new matter. Applicants respectfully request reconsideration and favorable action in this case.

Upon reviewing the Final Office Action, it became apparent that the claims as filed were different from the claims used to respond to the Office Action mailed August 4, 2005. Because of this, the arguments were directed to elements not found in the claims that were filed. Specifically, the limitation that the screen material be "diffusion bonded" was missing from the claims as filed. However, the claims have now been amended to include this. Since this differentiates the present invention from the art of record, Applicants respectfully request that this amendment be allowed and that Examiner's rejections be withdrawn.

**Claim Rejections 35 U.S.C. § 103(a) - Limitations Not Taught**

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either U.S. Patent 6,510,947 issued to Schulte et al. ("Schulte") or U.S. Patent Publication 2003/0132141 issued to Adams et al. ("Adams") in the alternative in view of U.S. Patent 5,842,522 issued to Echols et al. ("Echols"). Applicants respectfully traverse these rejections.

As to amended claims 1, 11, and 18, the cited references, even when combined, fail to teach or suggest removing particulate matter from a drilling fluid to reduce or eliminate the plugging of a sand control screen using a shale shaker screen formed of the same type of diffusion bonded material used to form the sand control screen.

As previously stated, Applicants recognize that one or more of the cited references teaches sintering screen layers together. Applicants respectfully submit, however, that the term “sintering” describes a process that is different from “diffusion bonding.” (See previous Response to Office Action).

Therefore, none of the cited references alone or in combination teach or suggest each and every element of all of the pending claims, namely removing particulate matter from a drilling fluid to reduce or eliminate the plugging of a sand control screen using a shale shaker screen formed of the same type of diffusion bonded material used to form the sand control screen. As such, the rejections of independent claims 1, 11, and 18 and corresponding dependent claims 2-10, 12-17, and 19-24 under 35 U.S.C. § 103(a) are unsupported and therefore should be withdrawn.

**Claim Rejections 35 U.S.C. § 103(a) - No Motivation to Combine**

Additionally, Applicants maintain that there is no motivation to combine the references. As previously stated, Examiner has provided no evidence or finding of the specific understanding or principle within the knowledge of a person of ordinary skill in the art at the time of the invention that would have supplied the motivation to combine the cited references. Previously, Examiner stated in part:

**It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a sand control screen as taught by Echols et al. in the wellbore of Schulte et al. or Adams et al. when the well is placed in production to prevent the production of sand as taught by Echols et al. (See col. 1, lines 13-29).**

**Alternatively, it would also have been obvious to use a shale shaker screen as taught by Schulte et al. or Adams et al. during the drilling operation to drill the wellbore of Echols et al. in order to remove solids from the drilling mud to minimize wear on mud pumps and other mechanical equipment used for**

drilling (*See* col. 1, lines 35-55 in Schulte et al. and paragraph [0011] in Adams et al.).

**Regarding claims 10, 14, 17, 21 and 22, one of ordinary skill in the art would have readily recognized that the selected pore size of a screen depends on the nature of the formation and would have been obvious.**

First Office Action, pp. 2-3; *See also*, Final Office Action, pp. 2-3

Examiner's statements clearly did not establish obviousness. As provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a prima facie case of obviousness.

In response to Applicants' previous request for evidence of suggestion or motivation to combine references, Examiner stated:

**Echols et al teach using their sand control screen in a well when the well is put on production to prevent the production of sand. Schulte et al or Adams et al teach using their shale shaker screen during the drilling of a borehole in order to remove solids from the drilling mud to minimize wear on mud pumps and other mechanical equipment used for drilling operation. The above-mentioned advantages provide one of ordinary skill in the art the motivation to combine.**

Final Office Action, p. 4 (citations omitted).

While it is advantageous to prevent the production of sand and it is also advantageous to remove solids from drilling mud, one of ordinary skill in the art would appreciate that drilling and production are two separate events. Further, one of ordinary skill in the art would not be motivated to combine a downhole sand screen with a surface shaker screen. The combination suggested by Examiner would require that events/devices that are separated temporally and geographically be united to achieve a result that neither achieves independently. This is not taught by the references. Further, Examiner's statement that "The above-mentioned advantages provide one of ordinary skill in the art the motivation to combine" does not establish

obviousness.<sup>1</sup> If the modification or combination of the prior art changes the principle of operation of the prior art, then the references are insufficient for prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *See also*, M.P.E.P. 2143.01(VI)

Additionally, Applicants contend that the combination suggested by Examiner does not result in the claimed invention. Even if the sand control screen of Echols were used in the wellbore of Schulte or Adams, it would not “remove particulate from drilling fluid to reduce plugging of a sand control screen” as required by the claims. Rather, the sand control screen of Echols “control[s] the movement of [] unconsolidated formations during the production of fluids.” (See column 1, lines 24-26). Preventing formation movement from entering production fluid is very different from removing particulates from drilling fluid. Since the combination of Echols/Schulte/Adams does not “remove particulate from drilling fluid to reduce plugging of a sand control screen,” it cannot be obvious to combine these references to get this result.

As to claims 10, 14, 17, 21, and 22, even if Examiner’s following statement were accurate, it would not be a basis for rejecting the claims:

**Regarding claims 10, 14, 17, 21 and 22, one of ordinary skill in the art would have readily recognized that the selected pore size of a screen depends on the nature of the formation and would have been obvious.**

This statement is insufficient to establish obviousness. A conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a prima facie case of obviousness. M.P.E.P. § 2144.03(C). Examiner’s statement that the selection of pore size depends on the nature of the formation is only partially correct. As stated in the specification at

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<sup>1</sup>MPEP § 2142 states “When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” (Citing. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)).

paragraph 0009, “sand control screens . . . are often custom-made for the particular application.”

However, as stated earlier in the same paragraph, shale shaker screens only come in a limited number of standard sizes. This results in one standard size shale shaker screen being used for many different applications to filter many different types and sizes of particulate matter. Therefore, it would not be obvious to use any non-standard pore sizes, much less the specific sizes set forth in claims 10, 14, 17, 21, and 22.

**SUMMARY**

In light of the above amendments and remarks, Applicants respectfully submit that the application is now in condition for allowance and earnestly solicit early notice of the same. Should Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, he is invited to contact the attorney of record by telephone, facsimile or electronic mail, as indicated below.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and direct that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*) Order Number 063718.0303.

Respectfully submitted,

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